



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,506	07/31/2001	John G. Babish	T8638.NP	2768

20995 7590 06/27/2003

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

PATTEN, PATRICIA A

ART UNIT	PAPER NUMBER
----------	--------------

1654

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,506

Applicant(s)

BABISH ET AL.

Examiner

Patricia A Patten

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 11-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of species with regard to claims 1-6, 11 and 16 in Paper No. 11 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The elected species was not found in the art. Thus, the Examiner has chosen another species for examination on the merits: costunolide as the sesquiterpene lactone, and glycyrrhizic acid as the triterpene. Because claims 11 and 16 do not read on these species, they have been withdrawn from consideration on the merits. Claims 7-10 which depend upon claim 6 will be examined on the merits.

Claims 1-42 are pending in the application. Claims 11-42 have been withdrawn from examination on the merits as being drawn to a non-elected invention.

Claims 1-10 were examined on the merits.

Specification

The disclosure is objected to because of the following informalities: The margins of Page 13 which contains Table 1 is outside the printable margin. Applicants are asked to submit a copy of page 13 which has a larger margin at the top of the page (i.e., approximately $\frac{3}{4}$ inch additional).

Appropriate correction is required.

Trademarks

The use of the trademarks 'Astac', 'Milliblot', 'immobilon', 'Scan Analysis', 'Microtech' and 'CalcuSyn' have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Drawings

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period

Art Unit: 1651

set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

The drawings are objected to because the text in the dark boxes of Fig. 3 is illegible. 'Andrographolide/PHA' in the key of Fig. 4(a) cannot be seen, nor is there a line associated with this value on the graph. Further 'Oleanolate/PHA' in the key of Fig 4(b) cannot be seen, nor can any line for Oleanolate/PHA be seen in the graph. Also, 'Ursolate/PHA' in the key of Fig. 4(c) cannot be seen, nor can any line corresponding to Ursolate/PHA be found on the graph. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated Yng-Wong (US 5,874,084) as evidenced by Harborne et al. (1999)*.

Yng-Wong (US 5,874,084) disclosed a composition comprising *Saussurea lappa* (costus root) and licorice *Glycyrrhizae glabra* (licorice root) (English Abstract). It is known that costus root inherently contains costunolide (sesquiterpene lactone) and that licorice root contains glycyrrhizic acid (triterpene) as evidenced by Harborne et al. (1999)* pages 666 and 739.

Glycyrrhizic acid, as evidenced by Harborne et al., occurred naturally in the glycosidic form (please see structure on p. 739).

The plant matter itself is considered a pharmaceutically acceptable carrier for the indigenous ingredients, thereby anticipating claims 4 and 9.

Because the compounds are present in the same composition, the nature of their respective origins does not materially change the composition (claims 2 and 12).

Art Unit: 1651

However, it is clear that the compounds are inherently present in each of the respective plants and are thus properties of the plant material. None-the-less, the compounds are present in the same composition irrespective of their origins, and thus anticipate this claim.

Both *Saussurea lappa* and *Glycyrrhiza labra* inherently contain vitamins, minerals, fats and proteins as they are plant material; well known in the art.

Therefore, the claims are anticipated by Yng-Wong.

*This reference is cited merely to relay an inherent property of *Saussurea lappa* and *Glycyrrhizae glabra* and is not used in the rejection *per se*.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Patricia Patten, whose telephone number is (703)308-1189. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. The official After final fax phone number is (703) 872-9307.

Art Unit: 1651

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

6/11/03

A handwritten signature in black ink, appearing to read "Patricia Patten", written in a cursive style.

Patricia Patten